

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ATSUSHI NAKAMURA, HIROYUKI HAYASHI  
and KAZUYA ITOU

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Appeal No. 2004-0157  
Application No. 09/706,771

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HEARD: February 17, 2004

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Before ABRAMS, FRANKFORT, and STAAB, Administrative Patent Judges.  
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-19, as amended after the final rejection (Paper No. 18), which are all of the claims pending in this application.

WE REVERSE.

### BACKGROUND

The appellants' invention relates to a suspension system for a steerable wheel. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Edahiro <u>et al.</u> (Edahiro)	5,009,449	Apr. 23, 1991
Ando	5,348,337	Sep. 20, 1994

Claims 1-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ando in view of Edahiro.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the Answer (Paper No. 15) for the examiner's complete reasoning in support of the rejection, and to the Brief (Paper No. 13) and Reply Brief (Paper No. 16) for the appellants' arguments thereagainst.

### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The appellants' invention is directed to the problem in a vehicle's steerable wheels wherein when braking force is applied during a turn the ball joint center of the turned wheel is caused to move, which results in degraded returnability of the wheel to the neutral position. The problem is solved in accordance with the appellants' invention by installing in the rearmost lower suspension link a resilient bushing which is less rigid in the width direction of the vehicle than in the longitudinal direction.

All of the claims stand rejected as being obvious<sup>1</sup> in view of the combined teachings of Ando and Edahiro. In particular, the examiner finds all of the subject matter recited in independent claim 1 to be disclosed or taught by Ando except that the resilient bushing of Ando "does not have a pair of hollow portions in the form of axial openings." However, the examiner is of the view that it would have been obvious to one of ordinary skill in the art to modify Ando by altering the bushing to meet the limitations recited in claim 1 "in order to reduce vibration transferred by the suspension link to the vehicle body," a teaching which the examiner attributes to Edahiro. The examiner further takes the position that such a modification "would inherently have the

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<sup>1</sup>The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

positive scrub radius recited in the claims.” See Answer, page 5. The appellants argue that no suggestion exists in either of the applied references which would have motivated the artisan to modify the Ando suspension system in the manner proposed by the examiner. We agree, and we will not sustain the rejection of independent apparatus claim 1 or independent method claim 16, which contains the same limitation, or of the claims depending therefrom. Our reasons for arriving at this conclusion follow.

Edahiro is directed to a rear suspension system for a motor vehicle. This reference discloses in Figures 7 and 8 a rear suspension arrangement which comprises a vertically oriented trailing arm 9 provided with an upper bushing 30 and a lower bushing 32. The bushings also are vertically oriented, and each bushing has a pair of opposed arcuate chambers (30d, 30e, 32d, 32e) connected to one another by passages (30f, 32f). The chambers of upper bushing 30 extend generally horizontally and this bushing causes the suspension system to resist deformation in the up and down direction, while the chambers in lower bushing 32 extend generally vertically and this bushing damps the suspension in the longitudinal direction (column 6, line 64-column 7, line 5).

We fail to perceive any teaching, suggestion or incentive in either reference which would have led one of ordinary skill in the art to modify the Ando front wheel suspension system in the manner proposed by the examiner. While it is true that Edahiro discloses bushings that resist deformation more in one direction than in the

other, there are several reasons why we are of the view that one of ordinary skill in the art would not have been motivated to install them in the Ando suspension system in the manner proposed by the examiner. First, the Edahiro bushings are disclosed in the context of a non-steerable rear suspension and are vertically oriented, and no evidence has been adduced by the examiner that would have suggested to the artisan that these bushings would or could be oriented horizontally and utilized in a steerable front wheel assembly. Second, Edahiro discloses two bushings in which the chambers are oriented perpendicularly to one another, which results in damping the suspension in both the vertical and the horizontal directions, but provides no suggestion as to which way only one of them should be arranged if installed horizontally, as would be necessary if placed in the Ando system. The examiner has, nevertheless, chosen to orient the single bushing to be placed in Ando in the direction required by the appellants' claims, which could only be the result of the hindsight afforded one who first viewed the appellants' disclosure. Third, since Edahiro is not attempting to solve the same problem as that to which the appellants' invention is directed, there is no evidence to support the conclusion that replacing the Ando solid bushing with the chambered bushing of Edahiro would solve any problem in the new environment, much less a vibration problem, and or would inherently solve the problem to which the appellants' invention is directed.

For the above reasons, we conclude that the combined teachings of Ando and Edahiro fail to establish a prima facie case of obviousness with regard to the subject matter recited in independent claims 1 and 16, and we will not sustain the rejection.

CONCLUSION

The rejection of claims 1-19 under 35 U.S.C. § 103(a) as being unpatentable over Ando in view of Edahiro is not sustained.

The decision of the examiner is reversed.

NEAL E. ABRAMS	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
CHARLES E. FRANKFORT	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	

NEA/lbg

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